

## Remarks

The Office Action dated March 11, 2004 has been carefully reviewed and the following comments are made in response thereto. In view of the following remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

### Summary of Final Office Action

1. Claims 1 to 4, 6, 7 and 9 to 15 were rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Tsai *et al.* with Garcia de Plazzo *et al.* to support inherency.
2. Claims 1 to 3, 6, 7 and 9 to 15 were rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Kufe *et al.*
3. Claims 1 to 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nagene *et al.* and Han *et al.* in view of Kondo *et al.*
4. Claims 1 to 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nagene *et al* and Han *et al* in view of Kondo *et al* and further in view of Howell *et al.*
5. Claims 1 to 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kufe *et al.* in view of Wagner *et al.* and Han *et al.*

### Rejection under 35 U.S.C. 102(b)

Claims 1 to 4, 6, 7 and 9 to 15 were rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Tsai *et al.* with Garcia de Plazzo *et al* to support inherency. Claims 1 to 3, 6, 7 and 9 to 15 were also rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Kufe *et al.* The Examiner indicated, however, that the claims would be allowable if claims 1, 9 and 13 were amended to require that the tyrosine kinase inhibitor be relatively selective for the mutant EGFR in the tissue being treated (see Office Action at page 9, item one). Applicants have amended these claims to require the tyrosine kinase inhibitor be relatively selective for the protein encoded by the mutant EGFR gene. Applicants submit that amended claim language falls within the scope of subject matter indicated by the Examiner to be allowable.

With regard to comparison to the cited references to the claimed invention, Applicants submit that the Tsai *et al.* reference clearly attributes the activity of the tyrosine kinase inhibitor to its effects on a wild-type EGFR (see page 1072, column 2, lines 14 to 15). The experimental data in this cited reference

further correlates the effect of the level of expression of the wild-type EGFR to the activity of the tyrosine kinase inhibitor (see page 1070, column 2, lines 25 to 29 and Figure 4).

The Kufe *et al.* reference, in a similar manner, goes to great measures to establish a relationship between the effect of the tyrosine kinase inhibitor and the expression of a wild-type EGFR. This reference also makes no mention of a mutant EGFR. To imply that the effects of the tyrosine kinase reported in the cited reference is due to an element not described in the reference (*e.g.*, a mutant EGFR) goes against the teachings of the cited reference, let alone the prior art. Applicants therefore submit that the cited references do not anticipate the claims because there is no evidence of expression of a mutant EGFR in the tested cell lines.

**Rejections under 35 U.S.C. 103(a)**

Claims 1 to 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nagene *et al.* and Han *et al.* in view of Kondo *et al.* Claims 1 to 16 were also rejected under 35 U.S.C. 103(a) as being unpatentable over Nagene *et al.* and Han *et al.* in view of Kondo *et al* and further in view of Howell *et al.* It has been established that Nagene *et al.* is not available as prior art (see Office Action dated July 3, 2003). In the absence of this reference, Applicants submit the that the rejections are therefore moot and request withdrawal of the rejections.

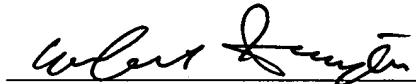
Claims 1 to 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kufe *et al.* in view of Wagner *et al.* and Han *et al.* In view of the claim amendments and indications of allowable subject matter made by the Examiner, Applicants submit that none of the cited references render obvious the amended claims and respectfully request withdrawal of the rejection.

Applicants respectfully request reconsideration of the subject application in view of the above remarks and withdrawal of the rejections. It is respectfully submitted that this application is now in condition for allowance. Should the Examiner believe it to be useful, an interview with the Examiner is respectfully requested in order to discuss the foregoing claims.

If there are any fees due in connection with the filing of this amendment, please charge the fees to our Deposit Account No. 50-310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Dated: **September 13, 2004**  
Morgan, Lewis & Bockius LLP  
Customer No. 09629  
1111 Pennsylvania Avenue, N.W.  
Washington, D.C. 20004  
202-739-3000

Respectfully submitted  
**Morgan, Lewis & Bockius LLP**

  
\_\_\_\_\_  
Robert Smyth  
Registration No. 50,801